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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,722	03/21/2001	Sylvain Chevreau	PF 980065	6135
7590 03/19/2007 Joseph S Tripoli Thomson Multimedia Licensing Inc CN 5312 Princeton, NJ 08543-0028			EXAMINER PICH, PONNOREAY	
			ART UNIT 2135	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/19/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/787,722

Applicant(s)

CHEVREAU ET AL.

Examiner

Ponnoreay Pich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/8/2007 has been entered.

### ***Response to Arguments***

Applicant's arguments were fully considered. Applicant argues that Linnartz does not teach identifying whether said digital data are encrypted. This is true. It is noted that the prior office action had a typo on page 2 (which has been corrected in this office action), wherein column 2, lines 10-19 of Linnartz was cited as teaching this limitation. The cited section was instead meant to point to Linnartz teaching identifying whether said digital data are *watermarked*, which is one of the limitations recited in the claim. However, Ranger was also cited as teaching identifying whether digital data are encrypted. Any confusion caused by this typo is regretted.

Applicant argues there is no reason to combine the subject matter of Ranger with Linnartz since Linnartz does not have encrypted data. The examiner respectfully disagrees. Linnartz does not limit the data to being encrypted or not. Linnartz is concerned with copy protection of digital data (col 2, lines 59-61). As evidenced by Ichinoi (col 4, lines 5-8), encryption was also well known method of protecting against unauthorized usage, thus because Linnartz does not disclose whether or not the files

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are encrypted, there is no reason to believe that encrypted files or at least partially encrypted files could not have been used with his system for further data control.

Ranger taught that if a file was encrypted, it could be difficult to detect if a data file was infected with a virus (col 1, lines 18-23). Ranger's teachings would help prevent Linnartz's system from being accidentally infected by a virus if the file was encrypted since Ranger's teachings would allow Linnartz to detect if the file was encrypted, thus requiring that the file be decrypted for virus scan (col 2, lines 24-28).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz (US 6,314,518) in view of Ranger et al (US 6,393,568).

#### **Claim 1:**

Linnartz discloses:

1. Identifying whether said digital data are watermarked (col 2, lines 10-19).
2. Delivering one of a permission and a prohibition to copy and/or to play said digital data as a function of an identification of a watermarking of said digital data (col 2, lines 10-19 and col 4, line 66-col 5, line 10).

Linnartz does not explicitly disclose identifying whether said digital data are encrypted and delivering one of a permission and prohibition to copy and/or to play said digital data as a function of an identification of an encryption of said digital data. However, Ranger discloses these limitations (col 2, lines 24-28, 50-56, and 64-67).

At the time applicant's invention was made, it would have been obvious to one skilled in the art to combine Linnartz and Ranger's teachings according to the limitations recited in claim 1. One skilled would have been motivated to incorporate Ranger's teachings because Ranger discloses that virus detection on encrypted data is not reliable (col 1, lines 18-23), thus there needs to be a way to detect if an encrypted file has a virus (col 1, lines 58-64). Determining if a file is encrypted so that it may be decrypted and scanned for a virus before use as taught by Ranger would prevent Linnartz's system from being infected with a virus. Note that Linnartz does not prohibit use of encryption with his data, thus as evidence by what is taught by Ranger, if encryption was used, infection by a virus from an encrypted or partially encrypted file is likely if there was no reliable way of determining whether or not the file was infected.

**Claim 2:**

Linnartz and Ranger further discloses the limitations recited in claim 2:

1. Identifying the type of the storage medium (Linnartz: col 4, lines 1-45).
2. Identifying whether a cryptographic signature accompanies said digital data (Linnartz: col 8, line 63-col 9, line 41).
3. Delivering a permission for digital copying when:

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- a. An encryption of said digital data has been identified (Ranger: col 2, lines 24-46).
- b. A watermarking of said digital data has been identified (Linnartz: col 2, lines 10-19 and col 4, line 66-col 5, line 10).
- c. A non-recordable type of storage medium has been identified (Linnartz: col 4, lines 1-18 and col 5, lines 25-44).
- d. A cryptographic signature accompanying said digital data has been identified (Linnartz: col 9, lines 13-41).

**Claim 3:**

As per claim 4, Ranger implicitly discloses delivering a permission for digital copying when an encryption of said digital data has not been identified (col 2, lines 24-63). Note that Ranger determines if a file is encrypted or not and if it was encrypted, decrypts the file, and scans the decrypted file for a viruses before allowing further processing of the file. If the file was identified as not encrypted, then no encryption of the digital data has been identified. It should be obvious to one skilled that scanning and processing of the file can proceed without decrypting the file, thus a permission for digital copying when an encryption of said digital data has not been identified. One skilled should appreciate that playback permission is also copy permission since computing devices executes/plays a file by copying the file to RAM first. If there is no playback permission, there is also no copy permission.

Linnartz further discloses delivering a permission for digital copying when a watermarking of said digital data has not been identified (col 5, lines 4-10). Note that if

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a content has no watermark, i.e. free copy state, then no watermarking can be identified. In such a state, permission is delivered.

**Claim 4:**

The first limitation recited in claim 4 is similar to the first limitation recited in claim 3 and is rejected for the same reasons. As per the limitation of delivering a prohibition of said digital data when a watermarking of said digital data has been identified, it is further disclosed by Linnartz (col 5, lines 30-47).

**Claim 5:**

Linnartz and Ranger further discloses the limitations recited in claim 5:

1. Identifying the type of the storage medium (Linnartz: col 4, lines 1-45).
2. Delivering a prohibition of copying when:
  - a. An encryption of said digital data has been identified (Ranger: col 2, lines 24-56).
  - b. A watermarking of said digital data has been identified (Linnartz: col 2, lines 10-19 and col 4, line 66-col 5, line 10).
  - c. A recordable type of storage medium has been identified (Linnartz: col 4, lines 1-18 and col 5, lines 35-44).

**Claim 6:**

Linnartz and Ranger further discloses the limitations recited in claim 6:

1. identifying the type of the storage medium (Linnartz: col 4, lines 1-45).
2. Identifying whether a cryptographic signature accompany said digital data (Linnartz: col 8, line 63-col 9, line 41).

3. Delivering a prohibition of copying when:

- a. An encryption of said digital data has been identified (Ranger: col 2, lines 24-46).
- b. A watermarking of said digital data has been identified (Linnartz: col 2, lines 10-19 and col 4, line 66-col 5, line 10).
- c. A non-recordable type of storage medium has been identified (Linnartz: col 4, lines 1-18 and col 5, lines 35-44).
- d. No cryptographic signature accompanying said digital data has been identified (Linnartz: col 8, line 63-col 9, line 6).

**Claims 8 and 12:**

Linnartz further discloses wherein the prohibition of digital copying comprises a blocking of output of the digital data (col 4, lines 1-3).

**Claim 10:**

Linnartz further discloses identifying the type of the storage medium; and delivering one of a permission and a prohibition to copy and/or to play said digital data as a further function of the identification of a recordable or non-recordable type of said storage medium (col 4, lines 1-45).

**Claim 11:**

Linnartz further discloses:

1. Identifying whether a cryptographic signature accompanies said digital data (col 8, line 63-col 9, line 41).



2. Delivering one of a permission and a prohibition to copy and/or to play said digital data as a further function of the identification of a cryptographic signature accompanying said digital data (col 8, line 67-col 9, line 8).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz (US 6,314,518) in view of Ranger et al (US 6,393,568) and further in view of Ichinoi (US 6,266,477).

**Claim 7:**

Linnartz does not explicitly disclose:

1. Converting the digital data into analog signals.
2. Corrupting the analog signals if a prohibition of digital copying is delivered.

However, Ichinoi discloses:

1. Converting the digital data into analog signals (col 3, lines 4-7 and col 4, lines 19-30).
2. Corrupting the analog signals if a prohibition of digital copying is delivered (col 11, lines 21-35).

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art further modify Linnartz's invention according to the limitations recited in claim 7 in light of Ichinoi's teachings. One of ordinary skill would have been

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motivated to incorporate Ichinoi's teachings in which digital data is converted to analog signals as Ichinoi recognizes that there are still technology that consumers have which are analog in nature, therefore in the art, there exists a need that digital systems be backwards compatible with them (col 1, lines 23-33 and col 2, lines 13-18).

Incorporating Ichinoi's teachings would satisfy this need for backwards compatibility. One of ordinary skill would have been motivated to incorporate Ichinoi's teachings of corrupting the analog signals if a prohibition of digital copying is delivered as it would help prevent copying of protected material (col 11, lines 33-35).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz (US 6,314,518) in view of Ichinoi (US 6,266,477) and further in view of Ranger et al (US 6,393,568).

**Claim 9:**

Linnartz discloses:

1. An output for delivering signals representative of the digital data upon playing said digital data (Fig 5, item 58).
2. Means for detecting:
  - a. Whether said digital data are watermarked (col 2, lines 10-19 and col 4, line 66-col 5, line 10).
  - b. Whether said storage medium is a recordable or non-recordable type (col 4, lines 1-18 and col 5, lines 35-44).

- c. Whether said storage medium contains a cryptographic signature accompanying said digital data (col 8, line 63-col 9, line 6).
- 3. A system for protection against the copying of said digital data, said system being able to receive signals from said means for detecting and to generate a copy permission signal or a copy prohibition signal as a function of the signals received from said means for detecting (col 4, lines 1-5 and col 5, lines 42-44).
- 4. Recording control means blocking the signals delivered at the digital output when said recording control means receives a copy prohibition signal from the copy protection system (col 5, lines 42-44).
- 5. A system for protection against playing, said playing protection system being able to receive signals from said means for detection and to generate a playing prohibition signal when it has been detected by said means for detecting that said digital data are watermarked (col 1, lines 47-55 and col 4, lines 1-5).
- 6. Playing control means being able to interrupt the playing of said digital data or the output to the output when said playing control means receives a playing prohibition signal from the playing protection system (col 1, lines 47-55 and col 1-5).

Note that the above limitations are disclosed in various embodiments of Linnartz's invention. It would have been obvious to one skilled in the art to combine the features of these various embodiments in one system. One skilled would have been

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motivated to do so because use of these multiple features would make piracy more difficult.

Linnartz does not explicitly disclose a digital output and an analog output for delivering analog signals. Linnartz does not explicitly disclose means for detecting whether said digital data are encrypted. Linnartz does not disclose a system for decrypting said digital data when an encryption is detected. Linnartz also does not disclose generating a play prohibition signal when it has been detected by said means for detecting that said digital data are not encrypted.

However, Ichinoi discloses digital and analog outputs (col 2, lines 13-18). Ranger discloses means for detecting whether said digital data are encrypted (col 2, lines 24-46). Ranger discloses a system for decrypting said digital data when an encryption is detected (col 2, lines 47-56). Ranger implicitly discloses generating a play prohibition signal when it has been detected by said means for detecting that said digital data are not encrypted (col 2, lines 24-63).

At the time applicant's invention was made, it would have been obvious to one skilled in the art to modify Linnartz's invention according to the limitations recited in claim 9 in light of Ichinoi and Ranger's teachings. One skilled would have been motivated to incorporate their teachings for the same reasons given in claims 1 and 7.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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